

REMARKS/ARGUMENTS

Reconsideration of the application is respectfully requested for the following reasons:

Rejection of Claims 1, 2, 5-12, 15, 16, 20-27, 30, 31, 33, 35, 40-47, 52-58, 63, 66 and 70 Under 35 U.S.C. §102(e)

Claims 1, 2, 5-12, 15, 16, 20-27, 30, 31, 33, 35, 40-47, 52-58, 63, 66 and 70 are rejected under 35 U.S.C. §102(e) as being anticipated by Duphorne et al. (U.S. 6,212,265). In the rejected claims, Claims 1, 20, 40 and 52 are independent.

Applicant respectfully traverse this rejection since Duphorne does not show the steps of filtering the identification information by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions, transferring the transmission signal in conjunction with a first signal and a second signal to a non-portable receiving terminal, and transforming the transmission signal back into the identification information. Moreover, Duphorne does not show the step of receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal, wherein the transmission signal is transformed from an identification information filtered by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions.

The method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises a step of transmitting a query signal to the

remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network, a step of formatting the preliminary email notification signal into the Caller ID-compatible email notification signal according to one or more parameter values, and a step of transmitting the Caller ID-compatible email notification signal from the central office to the user using the public switched telephone network. The method of Duphorne does not include the steps of filtering the identification information by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions, transferring the transmission signal in conjunction with a first signal and a second signal to a non-portable receiving terminal, and transforming the transmission signal back into the identification information.

Moreover, Duphorne does not show the step of receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal, wherein the transmission signal is transformed from an identification information filtered by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions. Instead, the system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. The ISP email server 16a receives a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in response to the query signal.

In addition, the Duphorne patent fails to teach a filtering device for suspending preliminary email notification signal in response to a

plurality of set deletion conditions prior to formatting the preliminary email notification signal into the Caller ID-compatible email notification signal. In contrast, the system of the claimed invention comprises a filtering device that stops transforming the identification information into the transmission signal if the electronic mail corresponds with some predetermined delete conditions, or transforms the identification information into the transmission signal if the electronic mail corresponds with some predetermined permission conditions.

In view of the above-described differences, which are positively recited in the claims, the teachings of Duphorne are insufficient to anticipate the claimed invention and withdrawal of the rejection is respectfully requested

Rejection of Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60, 71 and 73-83 Under 35 U.S.C. §103(a)

Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60, 71 and 73-83 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duphorne in view of Ozaki (U.S. 5,933,478).

The method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises a step of transmitting a query signal to the remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network, a step of formatting the preliminary email notification signal into the Caller ID-compatible email notification signal according to one or more parameter values, and a step of transmitting the Caller ID-compatible email notification signal from the central office to the user using the public switched telephone network.

With respect to Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, and 60, since fails to teach every element of the claimed invention, and Ozaki also fails to disclose the elements which Duphorne fails to teach, the combination of Duphorne and Ozaki fails to render the claimed invention unpatentable. According to MPEP § 2143, Basic Requirements of a Prima Facie Case of Obviousness, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That is, according to the last basic criteria of MPEP §2143, since Duphorne and Ozaki actually fail to teach or suggest all the claim limitations, the teachings of citations are insufficient to render the claimed invention unpatentable and thus Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, and 60 are patentable over Duphorne and Ozaki.

With respect to claim 71, and 73-83, the combination of Duphorne and Ozaki fails to teach the steps of transferring a transmission signal from an electronic mail provider to a receiving terminal which is predetermined by a corresponding user of said electronic mail, and transferring an identification information of said electronic mail to said receiving terminal when a response message from said receiving terminal is received within a predetermined period. According to the last basic criteria of MPEP §2143, the Duphorne and Ozaki patents fail to teach or suggest all of the claim limitations. The combination of Duphorne and Ozaki therefore fails to render the invention recited in claims 71 and 73-83 unpatentable.

With respect to claims 17, 32, 39 and 69, although Clayton (U.S. 5,875,234) discloses that the UART format is typically used for Caller ID services and Huna teaches a switch device for controlling operation of the receiving terminal, the combined teachings of Clayton and Huna still do not disclose the elements of the claimed invention which the teaching of Duphorne do not mention. The combinations of Duphorne and Clayton as well as Duphorne and Huna are therefore not sufficient to render the claimed invention prima facie obvious.

Conclusion

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

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